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TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No.
IDS-11605/14

In Re: ~~Application~~ Of: Venegas, Jr.

Serial No.
09/815,628

Filing Date
March 23, 2001

Examiner
MacArthur

Group Art Unit
3679

Invention: HAND RAIL SYSTEM

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:
March 11, 2003

Applicant is a small entity under 37 CFR 1.9 and 1.27.

A verified statement of small entity status under 37 CFR 1.27:

- ☐ is enclosed.
☐ has already been filed in this application.

The fee for filing this Appeal Brief is: **\$160.00**

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☒ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. A duplicate copy of this sheet is enclosed.
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Dated: May 12, 2003

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I certify that this document and fee is being deposited on 5-12-03 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

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5-19-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Venegas, Jr.

Serial No.: 09/815,628

Group No.: 3679

Filed: March 23, 2001

Examiner: Victor MacArthur

For: HAND RAIL SYSTEM

APPELLANT'S BRIEF UNDER 37 CFR §1.192

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Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

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I. Real Party in Interest

The real party and interest in this case is Frank Venegas, Jr., Applicant and Appellant.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The application was filed with 24 claims. In an amendment filed November 6, 2002, new claim 25 was added. In a response filed to a Restriction Requirement (Paper No. 5), Appellant elected claims 5-21 for further prosecution. In an amendment filed November 6, 2002, Appellant canceled claims 1-3, 9-14 and 22-24, leaving claims 4-8, 15-21 and 25 pending in the application. Claims 4, 16 and 18-21 have been withdrawn by the Examiner. Claims 5-8, 15, 17 and 25 are under appeal.

**IV. Status of Amendments Filed Subsequent
Final Rejection**

No after-final amendments have been filed.

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V. Concise Summary of the Invention

The present invention provides a knock-down hand rail assembly that is formed of both metal and plastic (Specification, page 3, lines 9-10). The assembly can also readily be disassembled to form a different hand rail structure configuration or to add more rails to the structure (Specification, page 3, lines 12-15). Further, the hand rail can be readily disassembled to change the plastic for the purpose of changing colors of the rail or adding/subtracting signage provided on the structure (Specification, page 3, lines 15-17). The knock down hand rail assembly of the present invention includes at least two spaced apart vertical rails and at least two base supports for supporting the vertical rails in an upright position. Alternatively, the vertical rails may be supported by the ground using standard coring procedures (Specification, page 3, line 19 to page 4, line 2). At least two spaced apart horizontal rails are provided and removably engaged with the vertical rails. These horizontal rails are preferably positioned above the base supports (Specification, page 4, lines 2-4). Each vertical and horizontal rail is surrounded by removable and replaceable polymerized sheathing. The polymerized sheathing has an interior diameter equal to or greater than the outer diameter of each rail (Specification, page 4, lines 4-6). Slip-on structural fittings are provided to removably engage the horizontal rails to the vertical rails (Specification, page 4, lines 6-7). In other preferred embodiments, a plurality of vertical and horizontal rails surrounded by polymerized sheathing and engaged by slip-on structural fittings can be used (Specification, page 4, lines 7-9). The vertical and horizontal posts or rails form a perimeter frame and define a framed area (Specification, page 4, lines 10-11). An infill panel is supported in the framed area. The infill panel may be a sheet of glass or polymer, steel mesh, or perforated steel (Specification, page 4, lines 11-13). In some versions, slip-on structural fittings engage and removably interconnect the horizontal and vertical rails. Clips or brackets interconnect to the infill panel with the vertical and horizontal rails (Specification, page 4, lines 13-15). In other embodiments, slip-in structural fittings are provided that have one end that engages the inner diameter of a horizontal or vertical rail, and another end that mounts to the side of another rail (Specification, page 4, lines 15-17).

VI. Concise Statement of Issues Presented For Review

1. Are claims 5, 6, 8, 15, 17 and 25 unpatentable over U.S. Patent No. 5,396,739 to Venegas, in view of U.S. Patent No. 4,053,140 to Clemens?

2. Is claim 7 unpatentable over U.S. Patent No. 5,396,739 to Venegas, in view of U.S. Patent No. 4,053,140 to Clemens, and further in view of U.S. Patent No. 5,186,438 to Cross et al.?

VII. Grouping of Claims for Each Ground of Rejection Which Appellant Contends

Appellant believes the following groups of claims represent patentably distinct subject matter requiring separate consideration on appeal:

Group I: Claims 5, 6, 8, 15, 17 and 25, wherein claims 5, 6, 8, 15 and 25 fall or stand with claim 17; and

Group II: Claim 7.

VIII. Argument

A. Group I - Claims 5, 6, 8, 15, 17 and 25, wherein claims 5, 6, 8, 15 and 25 fall or stand with claim 17.

Claim 17 was rejected under 35 U.S.C. §103 over the combination of U.S. Patent No. 5,396,739 to Venegas and U.S. Patent No. 4,053,140 to Clemens. In rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Appellant's claimed invention. There must be something *in the prior art* that suggested the combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembiczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

These holdings are directly applicable to the present case. While the Venegas case shows a guardrail assembly with polymerized sheathing, there is no teaching whatsoever as to providing vertical posts and upper and lower rails that are releasably engaged with one another. Also, Venegas fails to show polymerized sheathing that is removable and replaceable. The configuration of the guardrail in

Venegas prevents removal of the polymerized sheathing. Likewise, while the Clemens reference shows the use of structural fittings to removably interconnect various members, there is no teaching whatsoever as to the provision of posts and rails with removable and replaceable polymerized sheathing or the provision of an infill panel. It should be noted that the Clemens patent is directed to fiber reinforced plastic handrails, rather than rails that are covered with a plastic sheathing. Because there is no teaching or suggestion in either of the cited references that would lead one of skill in the art to combine the two references, the only motivation or teaching could only come from Appellant's own disclosure, resulting in an inappropriate rejection based on hindsight.

Appellant's invention provides a combination of elements not provided in any single piece of prior art, and not provided by an obvious combination of prior art. The provision of removable and replaceable polymerized sheathing allows semi-custom color choice and change of color of a handrail assembly according to the present invention. Also, the infill panel provides a function not provided by the prior art and an aesthetic appearance not provided by the prior art.

Even if the Venegas and Clemens devices were to be combined, it is unclear what would result. Clemens merely provides a plastic handrail, while Venegas provides a bent plastic sheathed metal rail with an infill panel attached to the metal portion of the rail. Consequently, the infill panel cannot be easily added to Clemens, and the Clemens' fittings cannot be applied to Venegas. Appellant submits that, just because it would be possible to somehow cherry-pick various elements from various pieces of prior art and combine them in accordance with the teaching of the present invention, the present invention is not merely an obvious combination of prior art elements.

B. Group II - Claim 7.

Claim 7 stands rejected under 35 U.S.C. § 103(a) over the Venegas/Clemens combination, and further in view of Cross et al., U.S. Patent No. 5,186,438. Appellant has already argued why the Venegas/Clemens combination is inappropriate and unjustified, and those arguments will not be repeated here. The Examiner concedes that Venegas does not disclose an infill panel in the form of a mesh screen, and further concedes that Clemens does not disclose an infill panel of any kind. Cross teaches mesh panels that can "withstand repeated strikes." What the Examiner fails to state in the final rejection, however, is that Cross et al. is directed to an entirely different field of endeavor, namely, a

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modular rock catchment barrier, such that "repeated strikes" would be anticipated and frequently occurring. Appellant's invention, on the other hand, uses infill panels for an entirely different purpose, namely, to contain persons and articles on staircases and walkways, for example. As such, were Appellant's system to be subjected to "repeated strikes," it would be due to temporary vandalism or some other highly unusually, unexpected phenomenon. Accordingly, it would not be obvious to modify the hand rail system of Appellant to incorporate the mesh panel of Cross, since the "purpose of better allowing the fence to withstand repeated strikes," as no logical nexus to the claimed invention on appeal.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and seeks the Board's concurrence at this time.

Respectfully submitted,

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Date: May 12, 2003

APPENDIX A**CLAIMS ON APPEAL**

5. The hand rail assembly as defined in claim 17, wherein the infill panel has an area which substantially consumes the framed area; the panel being mounted in the framed area.

6. The hand rail assembly as defined in claim 5, further comprising one or more sections of U-channel affixed to each of the vertical posts and the rails for mounting the infill panel.

7. The hand rail assembly as defined in claim 5, wherein the infill panel is a mesh screen.

8. The hand rail assembly as defined in claim 5, wherein the infill panel is a solid panel.

15. The hand rail assembly according to claim 17, further comprising structural fittings interconnecting the rails with the posts, at least one of the structural fittings comprising a slip-on fitting having an inner diameter greater than or equal to the outer diameter of the plastic sheathing on the posts or rails.

17. A hand rail assembly with an infill panel, comprising:

a pair of spaced apart vertical posts each having a lower end and an upper end, the lower ends being configured to engage a support surface, each of the posts having a height and an outside diameter; replaceable polymerized sheathing surrounding each of the posts, the sheathing having an inner diameter equal to or greater than the outside diameter of the posts, the sheathing extending substantially the entire height of the posts;

an upper rail extending between the upper ends of the vertical posts and releasably engaged to the upper ends of the vertical posts, the upper rail having a length and an outside diameter;

a lower rail extending between the vertical posts and positioned below the upper rail, the lower rail releasably engaged to the vertical posts and having a length and an outside diameter;

replaceable polymerized sheathing surrounding each of the rails, the sheathing having an inner

diameter equal to or greater than the outside diameter of the rails, the sheathing extending substantially the entire length of the rails;

the vertical posts and the rails together defining a perimeter frame having a framed area defined therein, the framed area having a top edge defined by the upper rail, a lower edge defined by the lower rail, and sides defined by the vertical posts; and

an infill panel supported in the framed area.

25. The hand rail assembly according to claim 17, wherein each of said horizontal rails and said vertical posts comprise substantially straight members and said polymerized sheathing is substantially straight.